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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,576	04/09/1999	RICHARD C. ALLEN	398802000600	8803

25226 7590 07/02/2003

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EXAMINER

FALK, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

23

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No.

09/289,576

Applicant(s)

ALLEN ET AL.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-17 and 19-36 is/are pending in the application.
- 4a) Of the above claim(s) 19-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The amendment filed April 23, 2003 (Paper No. 22) has been entered. Claims 37-40 have been cancelled.

Accordingly, Claims 1-6, 8-17, and 19-36 remain pending.

Claims 19-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made **without** traverse in Paper No. 10.

Accordingly, Claims 1-6 and 8-17 are examined herein.

The following rejections are reiterated and constitute the complete set of rejections being applied to the instant application. Rejections and objections not reiterated from the previous office action are hereby withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 27, 2002 (Paper No. 18) has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1632

Claims 1-6 and 8-17 stand rejected under 35 U.S.C. 112, first paragraph, for reasons of record advanced on pages 2-6 of the Office Action of Paper No. 12 (mailed 5/7/01), on pages 2-6 of the Office Action of Paper No. 16 (mailed 2/27/02), and on pages 3-6 of the Office Action of Paper No. 20 (mailed 11/18/02), as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

At pages 4-5 of the response, Applicants argue that the specification supplies all the required information to make and use the claimed invention and that Davis et al. (1991) teaches that increasing dopamine activity in the prefrontal cortex ameliorates symptoms associated with schizophrenia (pointing to p. 1479, right column to p. 1480, right column). However, as discussed in the previous Office Action, it is a huge leap to go from a suggestion to increase dopamine activity in the prefrontal cortex as a treatment for schizophrenic patients to actually providing an enabled protocol for achieving the desired treatment. The effect of dopamine replenishment in specific areas of the brain is unknown. Thus, one of skill in the art would look to the instant specification to provide these teachings. However, the instant specification does not adequately teach a protocol, as claimed, that could be used to effect the required level of dopamine replenishment.

At page 5 of the response, Applicants further argue that there is no reason to expect that the level of dopamine expression attainable in a Parkinson's disease patient is any different than that attainable in a patient with schizophrenia. However, evidence has been submitted to show that the etiology of schizophrenia is not well-understood (see National Institute of Mental Health, Schizophrenia, 1999, pp. 6-7). In cases involving unpredictable factors, such as most chemical reactions and physiological activity, scope of enablement varies inversely with degree of unpredictability of factors involved. *In re Fisher*, 166 USPQ 18 (CCPA 1970). Given the poor understanding of the etiology of schizophrenia, the fate of dopamine precursors produced in the prefrontal cortex of a diseased brain is unpredictable.

Art Unit: 1632

Given the lack of specific guidance in the instant specification for producing the claimed effect of treating the negative symptoms of schizophrenia, the limited working examples, the unpredictable state of the art with respect to *ex vivo* gene therapy and cell-based therapies, the broad scope of the claims, encompassing the use of any cell type as therapeutic, protective, or support cells, one of skill in the art would have been required to engage in undue experimentation to practice the claimed methods to effect treatment of schizophrenia.

Conclusion

No claims are allowable.

This application contains claims 19-36 drawn to an invention nonelected without traverse in Paper No. 10. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 10:00 AM to 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Art Unit: 1632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, William Phillips, whose telephone number is (703) 305-3482.

Anne-Marie Falk, Ph.D.

Anne-Marie Falk
ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER